

II. Provisional Obvious Double Patenting

The Office has provisionally rejected claims 22-58 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 29-61 of co-pending Application No. 09/600,136. (Office Action, page 2.) Applicants traverse the rejection. They respectfully request that the issue be held in abeyance until allowable subject matter is indicated.

III. Rejections Under 35 U.S.C. § 103

A. Aaslyng

The Office has rejected claims 22-24 and 27-31 under 35 U.S.C. § 103(a) as being unpatentable over WO 97/19998 ("Aaslyng"). The reasons for this rejection are given at pages 3-4 of the Office Action. Applicants respectfully traverse this rejection for the reasons that follow.

The Office admits that Aaslyng is deficient because "Aaslyng does not teach 3-methyl-4-aminophenol, heterocyclic couplers etc." (Office Action, page 3.) The Office urges, however, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute p-aminophenol with 3-methyl-4 amino phenol since patentee teaches them as equivalent coupler[s] listed on page 10 and line 2 in examples to formulate a composition for dyeing hair." (*Id.*, page 3-4.)

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

See M.P.E.P. § 2143. Furthermore, the suggestion or motivation must be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Aaslyng fails to provide the motivation necessary to support a *prima facie* case of obviousness because the skilled artisan looking to the teachings of *Aaslyng* would find no suggestion to choose Applicants' composition claimed in claim 22. *Aaslyng* generally teaches a dye composition comprising a laccase enzyme, one or more dye precursors, and optionally one or more dye modifiers. (*Aaslyng*, page 4, lines 12-17.) *Aaslyng* does not suggest substituting p-aminophenol with at least one of 3-methyl 4-aminophenol and its acid addition salts. The Federal Circuit has held that a generic formula does not by itself necessarily render a compound encompassed by that formula obvious. See *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994). The court in *In re Baird* noted that the disclosed generic formula of diphenol encompassed an abundance of different diphenol species, and the court therefore found no suggestion in the reference to select the particular combination of variables in that formula that would give rise to the claimed species in question. *Id.* at 382-83, 29 U.S.P.Q.2d at 1552. Similarly, *Aaslyng* discloses only p-aminophenol, and does not suggest to select the particular combination of variables that would give rise to 3-methyl 4-aminophenol. Accordingly, nothing in *Aaslyng* suggests that p-aminophenol is equivalent to at least one of 3-methyl 4-aminophenol and its acid addition salts. The only motivation to use the at least one oxidation base chosen from 3-methyl 4-aminophenol and its acid addition salts recited in claim 22 as a dye is found in Applicants' own specification.

Because *Aaslyng* does not provide the necessary motivation which would lead the skilled artisan to choose the at least one oxidation base recited in claim 22, there is no *prima facie* case of obviousness. Further, these remarks apply with equal force to the rest of claims 23-58. Hence, the rejection should be withdrawn with respect to all of claims 22-58.

B. Aaslyng in view of Audousset

The Office has rejected claims 22, 25-26, 32-58 under 35 U.S.C. § 103(a) as obvious over *Aaslyng* in view of *Audousset et al.* U.S. Patent No. 5,769,903 ("*Audousset*"). The reasons for this rejection are given at pages 4-6 of the Office Action. Applicants respectfully traverse this rejection for the reasons that follow.

As discussed above, *Aaslyng* fails to teach or suggest Applicants' claimed combination recited in claim 22. While the Office has applied *Audousset* to cure the deficiencies of *Aaslyng*, *Audousset* also fails to provide the missing motivation requisite for a *prima facie* case of obviousness.

Audousset is directed to a composition for the oxidation dyeing of keratin fibers, comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. (*Audousset*, column 2, line 8 to column 3, line 58.) Contrary to the Office's apparent assertion at the last two lines of page 5, *Audousset* teaches nothing at all about the enzymes of the laccase type recited in claim 22.

Hence, *Audousset* provides no motivation for using the at least one oxidation base recited in claim 22 and *Aaslyng* provides no motivation to use at least one enzyme of laccase type recited in claim 22. Other than improper hindsight, there is no reason to

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combine the two references. Although directed toward claim 22, these remarks apply with equal force to all of the other claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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